

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date set forth below as First Class Mail in an envelope addressed to: Commissioner for Patents, P O Box 1450, Alexandria, VA 22313-1450.

Date of Signature and Deposit: October 29, 2004

Nicholas J. Seay

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: James A. Thomson

Date: October 29, 2004

Serial No.: 09/982,637

Group Art Unit: 1632

Filed: 10/18/2001

Examiner: Joseph T. Woitach

For: PRIMATE EMBRYONIC STEM CELLS

Docket No.: 960296.97877

RESPONSE TO ADVISORY ACTION

Commissioner for Patents
P O Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In further response to the advisory action dated September 22, 2004 in the above-identified application, the applicant responds herewith as follows.

Enclosed with this submission is another Terminal Disclaimer, this disclaimer disclaims the term of this patent which would extend beyond the term of U.S. Patent No. 5,843,780. While it is believed that this Terminal Disclaimer is superfluous, since the term of U.S. Patent No. 6,200,806 has already been disclaimed so as to coincide with the termination of the '780 patent, an additional Terminal Disclaimer is submitted herewith to obviate this ground of rejection.

The applicant also wishes to express thanks to the Examiner Woitach for the interview on October 19, 2004. At that interview comments were presented which are capitulated in the document left with the Examiner at that time to be placed in the file of this application.

It is the further understanding of the applicant that the filing of this document will put the case in condition for allowance and that a notice of allowance will be forthcoming. Accordingly, that is solicited.

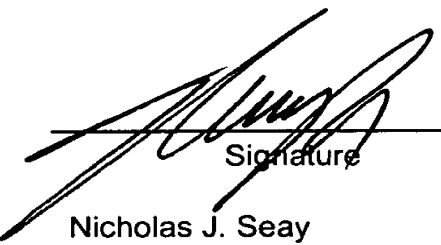
Respectfully submitted,

Nicholas J. Seay
Reg. No. 27,386
Attorney for Applicant
QUARLES & BRADY LLP
P.O. Box 2113
Madison, WI 53701-2113

TEL (608) 251-5000
FAX (608) 251-9166



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT | | Docket Number (Optional) 960296.97877 |
|---|--|--|
| <p>In re Application of: James A. Thomson Application No.: 09/982,637 Filed: 10/18/2001 For: Primate Embryonic Stem Cells</p> <p>Wisconsin Alumni Research Foundation</p> <p>The owner*, _____, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,843,780. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.</p> <p>In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.</p> <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input type="checkbox"/> For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p> <p>2. <input checked="" type="checkbox"/> The undersigned is an attorney or agent of record.</p> <div style="text-align: right;"><p> _____ Signature Nicholas J. Seay _____ Typed or printed name</p><p>10/29/2004 _____ Date</p></div> <p><input type="checkbox"/> Terminal disclaimer fee under 37 CFR 1.20(d) included.</p> <p>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p> <p>*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.</p> | | |

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.